

5, lines 14-16). Ron et al. teach the use of an injectable gel and/or microsphere as sequestering agents for osteogenic proteins. (Column 2, lines 2-6). Claims 1, 7, 12, and 26, consisting of the independent claims of Ron et al., recite either "an osteogenic protein" or "BMP-2," a specific osteogenic protein.

The present invention comprises claim 1, an independent claim to the implant, claim 2, a dependent claim to the microsphere, and additional dependent claims further specifying the properties of the implant and microspheres. Claims 1 and 2 recite the transition phrase "consisting of." Therefore, specifically excluding materials such as the osteogenic proteins of Ron et al.

The evidentiary record fails to show that each limitation of the present invention has been anticipated by the reference. Rejection under 35 U.S.C. § 102 requires the prior art disclose each and every limitation of the claimed invention. In determining anticipation, no claim limitation may be ignored. See *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990). Anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir 1986). There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102. See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

Claims 3, 4, 10-12, 14, 15, 17, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ron et al. and further in view of any of Ersek et al or Wallace et al. Neither Ersek nor Wallace, either alone or in combination, cure the defects of Ron. Each of the secondary references refers to the properties of the microspheres and introduce into the microspheres, or into its carrier gel, not recited in

the present invention. Such materials not recited in the present invention are excluded by the recitation of "consisting of."

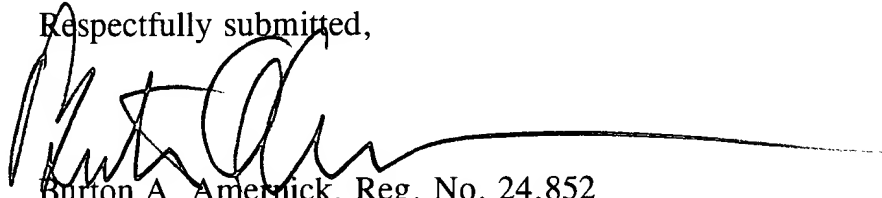
To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, (MPEP § 2143.03). When evaluating the scope of a claim, every limitation in the claim must be considered. See e.g. *In re Ochiai*, (MPEP § 2144.08). The evidentiary record fails to teach each limitation of the present invention.

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Director is hereby authorized to charge any fees, or credit any overpayment, associated with this communication, including any extension fees, to Deposit Account No. 22-0185.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Burton A. Amernick', with a long horizontal flourish extending to the right.

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